

REMARKS

With regard to the objections to the specification and drawings, a reference to Figures 5-7 is being submitted herewith, along with consideration addition to the text describing the aspects of Figure 5. In terms of the drawings, Figures 6 and 7 have been added. The Examiner will note that all of these materials were in the parent application which incorporated such materials by reference, that application now being U.S. Patent No. 6,267,785. Accordingly, no new matter has been added. In fact, antecedent basis for "score marks" is now carried by the additional material.

With regard to the claim rejections under 35 U.S.C. §112, the cited claims have been amended to provide the appropriate antecedent basis.

Claims 8-9 stand rejected under 35 U.S.C. §102(b) over Brown et al. ('061); claims 10-11 stand rejected under 35 U.S.C. §103 over Brown ('716). Applicant respectfully disagrees with the Examiner's reasoning for this rejection. In particular, among other differences, claim 8 includes the limitation of "a feature that encircles at least a part of the bone." In an attempt to address this limitation, the Examiner points to column 4, lines 44-47 of Brown '061, arguing that this discloses "a feature that encircles at least a portion of the bone." However, it does not. A more careful reading shows that the feature in question encircles item 42, which is the metal stem of a prosthetic component. As such, among other differences, Brown et al. does not teach or suggest this feature. Given that anticipation requires each and every element be present in a single piece of prior art, rejection under 35 U.S.C. §102(b) is expressly precluded.

As per claims 10-11, the Examiner states that "Brown as disclosed above . . ."

However, it is noted that the Examiner is now citing Brown '716 as opposed to Brown

'061. Perhaps this is a mistake. In any case, referring to the '716 patent, it would clearly never be obvious to one of skill in the art to modify Brown to fit the humerus or knee, since the entire point of Brown is directed to a hip prosthesis, and all of the apparatus is associated with that particular joint. That reference is made to different "prosthetic necks" in Brown is immaterial, since this clearly points to prosthetic necks of hip joints. As such, both Brown patents teach away from the Examiner's proposed rejection, defeating *prima facie* obviousness.

Based upon the foregoing, Applicant believes all claims are now in condition for allowance.

Respectfully submitted,

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Date: July 9, 2003